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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,504	01/14/2000	Min Teng	5686.200-US	8481

7590

02/11/2003

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EXAMINER

PATEL, SUDHAKER B

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/483,504

Applicant(s)

Min Teng et al

Examiner

SUDHAKER PATEL, D.Sc. Tech.

Art Unit

1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 14, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 17, 21, 26, 30, 36, 37, 52, 53, 65, and 66 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-4, 6, 17, 21, 26, 30, 36, 37, 52, 53, 65, and 66 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims(in part ) 1-4,6,17,21,26,30,36,37,52,53,65,6621, drawn to compounds, simple compositions, and a method of use for the generic Formula (I) of claim 1 wherein X = (=N-); V = =CD, classified in class 546, subclasses various depending on the variables L, M, A, B, and R1-R4. If this group is elected a single species with all variables must be exactly disclosed. Additionally, if this group is elected further restriction/election will be required as there are many unknowns.
  - II. Claims(in part)1-4,6,17,21,26,30,36,37,52,53,65,6621 , drawn to compounds, simple compositions, and a method of use for the generic Formula (I) of claim 1 wherein V = (=N-); X = =CD, classified in class 546, subclasses various depending on the variables L, M, A, B, and R1-R4. If this group is elected a single species with all variables must be exactly disclosed. Additionally, if this group is elected further restriction/election will be required as there are many unknowns.
  - III. Claims(in part)1-4,6,17,21,26,30,36,37,52,53,65,6621 , drawn to compounds, simple compositions, and a method of use for the generic Formula (I) of claim 1 wherein X = (=N-); V = (=N-), classified in class 544, subclasses various depending on the variables L, M, A, B, and R1-R4. If this group is elected a single

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species with all variables must be exactly disclosed. Additionally, if this group is elected further restriction/election will be required as there are many unknowns.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case compounds of reference U.S.P. 6503949 can also be used as glp-1 agonists .

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Claims 1,2,3,21,30,36,37,52 are generic to a plurality of disclosed patentably distinct species comprising quinoline , Benz-pyrazine wherein the bridges -L-A and -M-B could interchanged with respect to their positions. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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5. A telephone call was made to Elias Lammbiris ( Tel. 212 867 0123) on 2/6/03 to request an oral election to the above restriction requirement, but did not result in an election being made

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker Patel D.Sc.Tech. whose telephone number is (703) 308 4709.

The examiner can normally be reached on Monday thru' Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Dr.Mukund Shah can be reached at (703) 308 4716 or Sr. Examiner Mr. Richard Raymomnd at 703 308 4523.


A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

Application/Control Number: 09483504

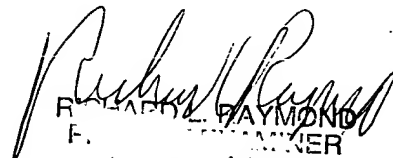
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Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308 1235.



SP/February 6, 2003.



RAYMOND E. FINNER  
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